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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/847,967 04/22/97 GOLDWASSER I 016703-00080

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EXAMINER

RICIGLIANO, J

ART UNIT

PAPER NUMBER

1618

14

DATE MAILED:

11/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/847,967

Applicant(s)
Goldwasser

Examiner
Joseph W. Ricigliano Ph. D.

Group Art Unit
1618



☒ Responsive to communication(s) filed on Sep 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2, 4, 5, 8, 10, 11, 15-24, 26, 29-36, and 42-73 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 2, 4, 5, 8, 10, 11, 15-24, 26, 29-36, and 42-73 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to applicants' response and amendment of 9/3/99.
2. Claims 1,3,6,7,9,12-14, 25, 27, 28, and 37-41 have been canceled
3. Claims 2, 4-5, 8, 10-11, 15-24, 26, 29-36, 42-73 are pending and being examined on their merits.

Election/Restriction

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

4. Applicants' election without traverse to prosecute claims covering delivery of materials by electron beam evaporation in Paper No.12a on page 11 is acknowledged.
5. In view of applicants' amendment the following additional election of species set forth.
6. Claims 42, 68, 70 and 72 are generic to a plurality of disclosed patentably distinct species comprising ^{sub}species of specific types of materials to be delivered (see for example the specification at pages 15-17), ^{sub}species of properties to be tested (see for example claim 26). Applicants are required under 35 U.S.C. 121 to elect a single disclosed species by electing a subspecies of

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material to be delivered to the array and of a subspecies of test property, even though this requirement is traversed.

Applicants are respectfully reminded that they have previously elected to have the materials delivered by electron beam evaporation and the election of materials to be delivered and the properties to be tested should be compatible with the prior election.

It is also noted that "solid" is a phase and as such a solid material is generic and as such.

7. Should applicant traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
8. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
9. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Ricigliano Ph. D. whose telephone number is (703) 308-9346.

The examiner can be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams Ph. D., can be reached at (703) 308-0570.

Joseph W. Ricigliano Ph. D.


KEITH D. MacMILLAN
PRIMARY EXAMINER